

**To:** Jill M. Pietrini([trademarksCC@sheppardmullin.com](mailto:trademarksCC@sheppardmullin.com))  
**Subject:** U.S. Trademark Application Serial No. 97426490 - SMITH - 30DR-166333  
**Sent:** May 12, 2023 12:58:37 PM EDT  
**Sent As:** [tmng.notices@uspto.gov](mailto:tmng.notices@uspto.gov)

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#### Attachments

**United States Patent and Trademark Office (USPTO)**  
**Office Action (Official Letter) About Applicant's Trademark Application**

**U.S. Application Serial No.** 97426490

**Mark:** SMITH

**Correspondence Address:**

Jill M. Pietrini  
SHEPPARD MULLIN RICHTER & HAMPTON LLP  
1901 AVENUE OF THE STARS, SUITE 1600  
LOS ANGELES CA 90067 UNITED STATES

**Applicant:** Smith, James Todd

**Reference/Docket No.** 30DR-166333

**Correspondence Email Address:** [trademarksCC@sheppardmullin.com](mailto:trademarksCC@sheppardmullin.com)

## NONFINAL OFFICE ACTION

**Response deadline.** File a response to this nonfinal Office action within three months of the “Issue date” below to avoid [abandonment](#) of the application. Review the Office action and respond using one of the links to the appropriate electronic forms in the “How to respond” section below.

**Request an extension.** For a fee, applicant may [request one three-month extension](#) of the response deadline prior to filing a response. The request must be filed within three months of the “Issue date” below. If the extension request is granted, the USPTO must receive applicant's response to this letter within six months of the “Issue date” to avoid abandonment of the application.

**Issue date:** May 12, 2023

This Office action is supplemental to the previous non-final Office action issued on February 10, 2023, in connection with this application. On May 10, 2023, applicant filed its Response to Office Action. Applicant's Response to Office Action raises a new issue that applicant must address; therefore, this nonfinal Office action is being issued to address the new issue. *See* TMEP §715.03(b).

Applicant's amended identification of goods and is accepted.

In a previous Office action dated March 3, 2023, the trademark examining attorney refused registration of the applied-for mark based on the following: (1) Section 2(d) Refusal; (2) Identification of Goods Requirement; and (3) Mark Description Requirement.

The trademark examining attorney notes that the following requirements are satisfied and/or obviated: (1) Identification of Goods Requirement; and (2) Mark Description Requirement. *See* TMEP §§713.02, 714.04.

Furthermore, the following refusal and requirement are **maintained and continued**: **Section 2(d) Refusal**

The following is a SUMMARY OF ISSUES that applicant must address:

- NEW ISSUE: Request for Information--Evidence Required to Support "Full Line Of" Identification
- MAINTAINED ISSUE: Section 2(d) Refusal

**Request for Information--Evidence Required to Support "Full Line Of" Identification:**

To permit proper examination of the application, applicant must submit additional product information about applicant's goods. *See* 37 C.F.R. §2.61(b); TMEP §814. The required product information should include fact sheets, instruction manuals, and/or advertisements. If these materials are unavailable, applicant should submit similar documentation for goods of the same type, explaining how its own product will differ. If the goods feature new technology and no competing goods are available, applicant must provide a detailed description of the goods.

Applicant has identified the following goods: "A full line of clothing for men, women, and children" in International Class 25. **"The USPTO will register a mark for a "full line of" a genre of goods . . . only when evidence shows the mark is actually used as such."** TMEP

§  
1402.03(c). Accordingly, to support this identification applicant **must** provide evidence to substantiate use for a full line of clothing. *Id.* Please note that this is **not** a requirement for a specimen. *Id.*

If applicant cannot establish sufficient use for "a full line of clothing for men, women, and children", applicant must amend the identification of goods to remove the indication "full line of" and the remaining wording must comply with the requirements for sufficient specificity as to such clothing goods. *Id.*

Factual information about the goods must clearly indicate how they operate, their salient features, and their prospective customers and channels of trade. **Conclusory statements regarding the goods will not satisfy this requirement.**

If applicant submits webpage evidence to satisfy this requirement, applicant must provide (1) an image of the webpage, (2) the date it was accessed or printed, and (3) the complete URL address. *In re ADCO Indus.-Techs., L.P.*, 2020 USPQ2d 53786, at \*2 (TTAB 2020) (citing *In re I-Coat Co.*, 126 USPQ2d 1730, 1733 (TTAB 2018)); TMEP §710.01(b). Providing only a website address or hyperlink to the webpage is not sufficient to make the materials of record. *In re ADCO Indus.-Techs., L.P.*, 2020 USPQ2d 53786, at \*2 (citing *In re Olin Corp.*, 124 USPQ2d 1327, 1331 n.15 (TTAB 2017); *In re HSB Solomon Assocs., LLC*, 102 USPQ2d 1269, 1274 (TTAB 2012); TBMP §1208.03); TMEP §814.

**Applicant has a duty to respond directly and completely to this requirement for information.** See *In re Ocean Tech., Inc.*, 2019 USPQ2d 450686, at \*2 (TTAB 2019) (citing *In re AOP LLC*, 107 USPQ2d 1644, 1651 (TTAB 2013)); TMEP §814. Failure to comply with a requirement for information is an independent ground for refusing registration. *In re SICPA Holding SA*, 2021 USPQ2d 613, at \*6 (TTAB 2021) (citing *In re Cheezwhse.com, Inc.*, 85 USPQ2d 1917, 1919 (TTAB 2008); *In re DTI P'ship LLP*, 67 USPQ2d 1699, 1701-02 (TTAB 2003); TMEP §814).

#### **Notes:**

With respect to applicant's argument against the Section 2(d) Refusal, applicant cites numerous registered marks that incorporate the word SMITH to argue that the present mark should likewise be registered. However, it is well settled that each application must be decided on its own facts; **the USPTO is not bound by prior decisions involving different records**. See *In re Boulevard Ent., Inc.*, 334 F.3d 1336, 1343, 67 USPQ2d 1475, 1480 (Fed. Cir. 2003) (citing *In re Nett Designs, Inc.*, 236 F.3d at 1342, 57 USPQ2d at 1566); *In re Datapipe, Inc.*, 111 USPQ2d 1330, 1336 (TTAB 2014); TMEP §1209.03(a).

Furthermore, the applicant's mark is the only SMITH formative mark for apparel goods that is virtually identical to the cited registered mark. As previously noted, these marks are virtually identical in appearance, sound, and meaning, “and have the potential to be used . . . in exactly the same manner.” *In re i.am.symbolic, llc*, 116 USPQ2d 1406, 1411 (TTAB 2015), *aff'd*, 866 F.3d 1315, 123 USPQ2d 1744 (Fed. Cir. 2017). Additionally, because they are virtually identical, these marks are likely to engender the same connotation and overall commercial impression when considered in connection with applicant's and registrant's respective goods. *Id.* The cited marks that applicant included in its Response to Office Action ***all include additional distinctive wording***. Here, however, applicant's mark includes ***no additional distinctive wording*** to distinguish its mark from the cited registration. Accordingly, applicant's argument is unpersuasive in overcoming the stated refusal.

#### **Assistance:**

If applicant has questions regarding this Office action, please telephone or e-mail the assigned trademark examining attorney. All relevant e-mail communications will be placed in the official application record; however, an e-mail communication will not be accepted as a response to this Office action and will not extend the deadline for filing a proper response. See 37 C.F.R. §§2.62(c), 2.191; TMEP §§304.01-.02, 709.04-.05. Further, although the trademark examining attorney may provide additional explanation pertaining to the refusal(s) and/or requirement(s) in this Office action, the trademark examining attorney may not provide legal advice or statements about applicant's rights. See TMEP §§705.02, 709.06.

**How to respond.** File a [response form to this nonfinal Office action](#) or file a [request form for an extension of time to file a response](#).

/David Dubin/  
David Dubin  
Examining Attorney  
LO107--LAW OFFICE 107  
(571) 270-0958  
David.Dubin@USPTO.GOV

## RESPONSE GUIDANCE

- **Missing the deadline for responding to this letter will cause the application to [abandon](#).** A response or extension request must be received by the USPTO before 11:59 p.m. **Eastern Time** of the last day of the response deadline. Trademark Electronic Application System (TEAS) [system availability](#) could affect an applicant's ability to timely respond. For help resolving technical issues with TEAS, email [TEAS@uspto.gov](mailto:TEAS@uspto.gov).
- **[Responses signed by an unauthorized party](#)** are not accepted and can **cause the application to [abandon](#)**. If applicant does not have an attorney, the response must be signed by the individual applicant, all joint applicants, or someone with [legal authority to bind a juristic applicant](#). If applicant has an attorney, the response must be signed by the attorney.
- If needed, **find [contact information for the supervisor](#)** of the office or unit listed in the signature block.

## United States Patent and Trademark Office (USPTO)

### USPTO OFFICIAL NOTICE

Office Action (Official Letter) has issued  
on May 12, 2023 for  
**U.S. Trademark Application Serial No. 97426490**

A USPTO examining attorney has reviewed your trademark application and issued an Office action. You must respond to this Office action to avoid your application abandoning. Follow the steps below.

- (1) **[Read the Office action](#)**. This email is NOT the Office action.
- (2) **Respond to the Office action by the deadline** using the Trademark Electronic Application System (TEAS). Your response, or extension request, must be received by the USPTO on or before 11:59 p.m. **Eastern Time** of the last day of the response deadline. Otherwise, your application will be [abandoned](#). See the Office action itself regarding how to respond.
- (3) **Direct general questions** about using USPTO electronic forms, the USPTO [website](#), the application process, the status of your application, and whether there are outstanding deadlines to the [Trademark Assistance Center \(TAC\)](#).

After reading the Office action, address any question(s) regarding the specific content to the USPTO examining attorney identified in the Office action.

### GENERAL GUIDANCE

- **[Check the status](#) of your application periodically** in the [Trademark Status & Document Retrieval \(TSDR\)](#) database to avoid missing critical deadlines.
- **[Update your correspondence email address](#)** to ensure you receive important USPTO notices about your application.
- **[Beware of trademark-related scams](#)**. Protect yourself from people and companies that may try to take financial advantage of you. Private companies may call you and pretend to be the USPTO or may send you communications that resemble official USPTO documents to trick you. We will never request your credit card number or social security number over the phone. Verify the correspondence originated from us by using your serial number in our database, [TSDR](#), to confirm that it appears under the “Documents” tab, or contact the [Trademark Assistance Center](#).
- **[Hiring a U.S.-licensed attorney](#)**. If you do not have an attorney and are not required to

have one under the trademark rules, we encourage you to hire a U.S.-licensed attorney specializing in trademark law to help guide you through the registration process. The USPTO examining attorney is not your attorney and cannot give you legal advice, but rather works for and represents the USPTO in trademark matters.